



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,329	06/02/2000	Martin Hollis	723-749	7163

23117 7590 11/04/2004
NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER	
GOOD JOHNSON, MOTILEWA	
ART UNIT	PAPER NUMBER
2672	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DT

Office Action Summary	Application No.	Applicant(s)	
	09/585,329	HOLLIS ET AL.	
	Examiner	Art Unit	
	Motilewa A. Good-Johnson	2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-14,16-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-14,16-22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2672

DETAILED ACTION

1. This office action is responsive to the following communications: Application, filed 06/02/2000; IDS, paper #4, filed 02/13/2001; IDS, paper #5, filed 09/05/2001; IDS, paper #6, filed 06/06/2001; Amendment A, filed 03/24/2003.
2. Claims 1, 5-14 and 16-22, and 24 are pending in this application.
3. The present title of the application is "Variable Bit Field Encoding" (as originally filed).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 5-14 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims that are noted above as being rejected but that are not specifically cited below are rejected based on their dependency on rejected independent claims as incorporating the errors of those claims and not imparting any features leading to statutory subject matter.

Regarding claims 1 and 5, the claim recites "a storage medium storing plural image elements that together represent an image . . .", and "a computer graphics system including a storage device . . ." The disclosed invention has a practical application, e.g., the storage of data element representing an image. However, the

Art Unit: 2672

steps of the method do not recite any post-computer process activity, i.e., no independent physical acts, and the steps of the method do not recite any pre-computer process activity, i.e., no manipulation of data representing physical objects or activities.

Regarding claim 14, the claim recites an encoding format, however the recited claim merely discloses an abstract idea.

Regarding claim 18, the claim recites "a method of representing an image with multiple data element . . .", however it is not within the technological arts.

Regarding claim 21, the claim recites "an alpha component converter . . .", however fails to disclose post-computer activity.

Therefore, in order to determine if the process is statutory, one must determine what the computer does to achieve a practical application. A process that merely manipulates an abstract idea is non-statutory despite the fact that it might inherently have some usefulness. For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea. Examiner finds no limitation to a practical application for the claimed method. The nonfunctional descriptive matter could be a page stored on a storage medium. The preamble of the claim is given little weight in establishing a statutory claim when there are no elements in the claim limitations into which the preamble could give substantial meaning of a practical limitation. Therefore, when taken as a whole, the claim recites manipulation of an abstract idea. See *In re Schrader*, 22 F.3d 290, 30 USPQ2d 1455 (Fed. Cir. 1994), and *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 2, 5-14, and 16-22 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Motilewa A. Good-Johnson whose telephone number is (703) 305-3939. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Razavi can be reached on (703) 305-4713. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Motilewa A. Good-Johnson
Examiner
Art Unit 2672

mgj
October 29, 2004



MICHAEL RAZAVI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600